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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,069	07/11/2001	Yoshiki Nakagawa	1581/00262	2380

7590 12/16/2003

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PO Box 19088  
Washington, DC 20036-0088

EXAMINER
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WILSON, DONALD R

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 12/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/807,069

Applicant(s)

NAKAGAWA ET AL.

Examiner

Donald R Wilson

Art Unit

1713

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s): See attachment.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

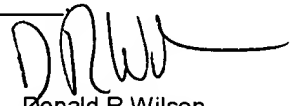
The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1-4,6-9 and 11-18.Claim(s) withdrawn from consideration: 5,10 and 19-31.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

  
Donald R Wilson  
Primary Examiner  
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**ADDITIONAL COMMENTS*****R spons to Proposed Amendment After Final***

1. Applicant's proposed amendment filed 11/28/03, after final rejection, has been fully considered with the following results.
2. The proposed amendment will be entered upon filing of an appeal and the rejection of Claim 17 under 35 U.S.C. § 112, second paragraph, in regards to "*an ethylenically unsaturated monomer*" is *withdrawn*". However, the rejection under 35 U.S.C. § 112, second paragraph, will still be maintained because the scope of what applicant is claiming remains indefinite because of the lack of any description of groups  $R^{22}$  and  $R^{23}$ , and the fact that at least one of  $R^{22}$  and  $R^{23}$  would presumably need to be hydrogen as a vinyl group is defined as " $CH_2=CH-$ ". The argument that "*--- the scope of what the applicant is claiming is definite because the vinyl monomer is illustrated in detail on page 7, line 8 to page 8, line 15 of the specification and thus the groups  $R^{22}$  and  $R^{23}$  are clear to person of skill in the art*" is not deemed to be persuasive because the limitations on which applicant relies are not stated in the claims.

It is claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064. Claims may be interpreted in the light of the specification for the purpose of defining a given term under 35 USC 112 but it must be remembered that during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow. *In re Zletz*, 13 USPQ 1320. Generally, one does not read into claims in pending applications limitations from the specification. *In re Winkhaus*, 188 USPQ 129; *In re Prater*, 162 USPQ 541.

Further, what applicant refers to as illustrated in detail are exemplary compounds which do not define the metes and bounds of what is being claimed.

3. Applicant's argues the following:  
  
*"The group of the general formula (1) undergoes dimerization on exposure to light or heat (see page 48, line 25 of the specification). As a result, the vinyl polymer of the present invention changes into a thermoplastic elastomer, which shows higher strength and elongation than the predimerization polymer, and which shows rubber-like elasticity (See Examples 3 and 4 of the instant specification)."* (Underlining added.)

However, this is at odds with the referenced examples which show that the products are cured in the presence of peroxides, which is a *thermosetting* reaction and would not result in a thermoplastic

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composition as alleged. The referenced places in the specification provide no teaching of thermoplasticity, and applicant has provided no evidence to support a product with preferred properties over the cured polymers of EP'036 with terminal acryloyl groups. As to curing by a dimerization mechanism it is also pointed out that the cited portion at page 48 only teaches dimerization when the terminal group is a cinnamate group as opposed to the scope of what is being claimed in general formula (1).

4. Applicant's arguments that, (i) none of the references provide any suggestion or motivation to combine their teachings to arrive at the present invention, and (ii) the examiner's conclusion of obviousness is based upon improper hindsight reasoning, are not deemed to be persuasive for reasons of record.

5. In regards to the argument that the cited art fails to provide the degree of predictability of success of achieving the properties attainable by the present invention needed to sustain the rejection under 35 U.S.C. § 103(a), *prima facie* obviousness requires only that a reasonable expectation of success exist; absolute predictability is not required. *In re O'Farrell* 7 USPQ 2d 1673. Applicant has provided no basis to believe that the polymers taught by EP'036, with cinnamate terminal groups as would have been obvious from the combined teachings with Mandal, Baudin, Muzyczko and/or Nishikubo, would not be photocurable, nor that the properties would not be equivalent to the polymers with other known photocurable alkenyl groups.

6. It is noted that in formula (1) of Claim 1 the first "R<sup>2</sup>" should read "R<sup>1</sup>" as in the originally presented claim. On filing of an appeal an amendment correcting this obvious oversight would be accepted.

#### ***Future Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald R Wilson whose telephone number is 703-308-2398 (571-272-1113).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 703-308-2450 (571-272-1114). The fax phone numbers for the organization where this application or proceeding is assigned is (703) 872-9306 for regular communications. The unofficial direct fax phone number to the Examiner's desk is 703-872-9029 (571-273-1113).

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-2351.

The Examiner is expected to move to the new Office about Christmas time. New telephone numbers known to the Examiner are indicated in parentheses.

A handwritten signature in black ink, appearing to read 'DR Wilson', with a long horizontal line extending to the right.

Donald R Wilson  
Primary Examiner  
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